

REMARKS

In the office action of July 13, 2005, the Examiner rejected claims 1-43 based on Van Eps, Ikuma and Nyack et al. and rejected the claims under Section 112. The Examiner also cited Cox as being of interest. Applicant provides the following remarks.

Applicant has amended the claims in such a manner as to clarify any unclear terms. Therefore, it is request that the rejection under section 112 be withdrawn.

Before discussing the rejections based on 35 U.S.C. § 103, it is thought proper to briefly state what is required to sustain such a rejection. The real issue under Section 103 is whether the Examiner has stated a case of prima facie obviousness.

The PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted). In establishing a prima facie case of obviousness, the PTO "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Id. at 1600. While Applicant admits that virtually every element of a claim may be found somewhere in the prior art, this is not the test to determine whether the prior art renders the invention obvious. Rather, "[t]he test is whether the claimed invention as a whole, in light of all the teachings of the references in their entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made." Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

Applicant believes that the Examiner has failed to make a prima facie case of obviousness in that he has failed to show either (a) some objective teaching in the prior art that suggests combining the references, or (b) knowledge generally available to one of ordinary skill in the art which would lead that individual to combine the relevant teachings of the references to achieve the invention claimed. See In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Applicant respectfully traverses the rejection of claims 1-7, 21 and 22. The Examiner suggests that it would be obvious to use the pick-up of Ikuma on the head of Van Eps. Not only is there no teaching or suggestion to combine in either reference, one of ordinary skill in the art would appreciate the failings of such a combination. For example, Ikuma is designed to be mounted in the opening of an acoustic guitar. A guitar is made of wood and the pick-up is held in place by the wood. A banjo head is made from a thin plastic membrane. Disposing the pick-up of Ikuma on a banjo head would likely damage the head. In fact, the fragility of the banjo head is demonstrated by Cox - which provides a plastic support around the hole in the head. One skilled in the art would not attempt to mount a pick-up like Ikuma in the head of Van Eps.

Even if the head were strong enough to hold the Ikuma pick-up, one skill in the art would not make the suggested combination. As noted in paragraph 0006 of the application, attempts to place a transducer on the head have resulted in muffled sound. Carrying an entire pick-up system on the head would simply exacerbate the problem. Thus, one of ordinary skill in the art would appreciate that the Van Eps and Ikuma should not be combined as suggested by the Examiner. Thus, claims 1-7, 21 and 22 should be allowed.

Applicant also respectfully traverses the rejection of claims 8-16. Nothing in any of the references suggest placing a pick-up inside of the body of the banjo. Van Eps simply attempts to

reflect sound out of the banjo, which is already done in part by the resonator. Simply put, there is nothing in any of the cited references which suggests modifying a banjo as set forth in these claims.

With respect to claim 17, nothing in the prior art suggests forming multiple holes in the head of a banjo. To the contrary, the thin plastic nature of the head would suggest against forming a plurality of holes therein. Thus, claim 17 and all claims dependent thereon should be allowed.

Claims 23 through 33 are also allowable. While the office action does not specifically address the elements of claim 23, Applicant notes that none of the prior art teaches or suggests placing a mounting place on a tension bar. Thus, the combination raised by the Examiner cannot be said to render claims 23-33 obvious. Claims 24 through 33 add additional points of novelty which are not shown in the prior art.

Claims 34 is also allowable over the prior art. None of the art cited teaches or suggests a pick-up with a control box which is contoured to the curvature of the banjo. Of course, in an electric guitar, the control body is formed in the body of the guitar. Nothing in the other references suggest applicant's solution. Thus, claim 34 and all claims dependent thereon should be allowed.

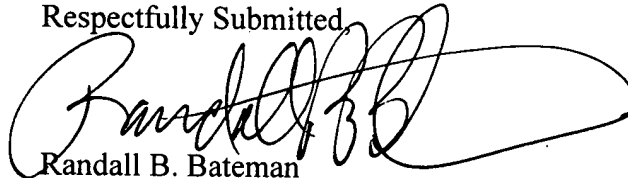
Claim 43 is also allowable, as none of the prior art teaches or suggests placing a pick-up in the body of the banjo. While Van Eps suggests reflecting sound, current banjos already have a resonator, thereby taking away any teaching from Van Eps that would suggest modifying the inside of the body.

Thus, Applicant submits that all pending claims are allowable over the cited art.

Applicant believes that no fee is necessary with the above amendment. The Commissioner is hereby authorized to debit any amount owing or credit any overpayment to Deposit Account No. 50-2720.

Should the Examiner have any questions or concerns regarding the preceding amendment, it is requested that she contact Applicant's counsel, Randall B. Bateman, at (801) 533-0320.

Respectfully Submitted

A handwritten signature in black ink, appearing to read "Randall B. Bateman", with a large, sweeping loop at the end.

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